UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,621	12/05/2001	Hyo Joon Park	3882-0101P	8155

2292 7590 02/09/2005

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER	
GELAGAY, SHEWAYE	
ART UNIT	**PAPER NUMBER**
2133	

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,621	PARK, HYO JOON	
	Examiner	Art Unit	
	Shewaye Gelagay	2133	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-21* is/are pending in the application.

4a) Of the above claim(s) *1-5* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/05/01*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-5 have been cancelled.

2. Claims 6-21 have been examined.

Drawings

3. The applicant is requested to submit drawings to facilitate understanding of the invention. Since the applicant is claiming a structure such as a central digital product registration server, a local digital product registration server and a manufacturer. The invention will be better understood with accompanying drawings.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 6-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeBOURGEOIS WIPO Publication WO 98/42098 in view of Menezes et al. publication entitled "Handbook of Applied Cryptography."

As per claim 6:

LeBOURGEOIS teaches a method of controlling digital product licensing using product registration servers, comprising the steps of:

registering the manufacturer to the central digital product registration server and receiving a partial user-ID file from the central digital product registration server; (Page 10, lines 1-6)

registering a digital product with player information to the central digital product registration server and receiving a product registration file of the product from the central digital product registration server; (Page 10, lines 7-9)

distributing product information to all local digital product registration servers by the central digital product registration server; (Page 10, lines 17-24) and

merging the product and the product registration file and encrypting them to produce a digital product in a public format. (Page 10, lines 12-17)

LeBOURGEOIS does not explicitly disclose a method of creating a secret/public key pair for a digital product manufacturer by using a manufacturer digital product license control program installed on a manufacturer computer; and transmitting the manufacturer's public key to a central digital product registration server and receiving a public key of the central digital product registration server.

Menezes et al. in analogous art, however, discloses a method of creating a secret/public key pair and transmitting the public key. (Section 13.4, page 555-556 and Figure 13.3)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the method disclosed by LeBOURGEOIS to include a method of creating a secret/public key pair for a digital product manufacturer by using a manufacturer digital product license control program installed

on a manufacturer computer; and transmitting the manufacturer's public key to a central digital product registration server and receiving a public key of the central digital product registration server. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, Menezes et al. (Page 555, Section 13.4) in order to guarantee or verify the authenticity of public keys. This way, the central digital product registration server verifies the identity of the manufacturer before issuing any licensing.

As per claim 7:

LeBOURGEOIS and Menezes et al. teach all the subject matter as discussed above. In addition, LeBOURGEOIS further discloses a method wherein the central and local registration servers are integrated into a single server. (Page 11, lines 1-10)

As per claim 9:

LeBOURGEOIS and Menezes et al. teach all the subject matter as discussed above. In addition, LeBOURGEOIS further discloses a method wherein the registered digital product information includes a product ID, price, and player name. (Page 18, lines 24-35)

6. Claims 8, 10-11, 13-14 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeBOURGEOIS WIPO Publication WO 98/42098 in view of Menezes et al. publication entitled "Handbook of Applied Cryptography." and further in view of Downs et al. United States Letter Patent Number 6,574,609.

As per claim 8:

LeBOURGEOIS and Menezes et al. teach all the subject matter as discussed above. Both references do not explicitly disclose a method wherein the manufacturer digital product license control program attaches the manufacturer's secret/public key pair and the public key of the central digital product registration server to the partial user-ID file that includes manufacturer information encrypted by the manufacturer's public key and digitally signed by a secret key of the registration server.

Downs et al. in analogous art, however, disclose a method wherein the manufacturer digital product license control program attaches the manufacturer's secret/public key pair and the public key of the central digital product registration server to the partial user-ID file that includes manufacturer information encrypted by the manufacturer's public key and digitally signed by a secret key of the registration server. (Col. 13, lines 42-48; Col. 14, lines 18-27 and lines 54-67; Col. 30, 8-10)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the method disclosed by LeBOURGEOIS and Menezes et al. to include a method wherein the manufacturer digital product license control program attaches the manufacturer's secret/public key pair and the public key of the central digital product registration server to the partial user-ID file that includes manufacturer information encrypted by the manufacturer's public key and digitally signed by a secret key of the registration server. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, Downs et al. (Col. 7, lines 42-45) in order to use a security system that uses cryptography, digital signatures and digital certificates to provide

protection against unauthorized interception or modification of electronic information and content.

As per claim 10

LeBOURGEOIS and Menezes et al. teach all the subject matter as discussed above. Both references do not explicitly disclose a method further comprising: creating a secret/public key pair for a user by using a user digital product license control program installed on a user computer; selecting a particular local digital product registration server from a digital product registration server list; sending the user's public key to the selected local registration server and receiving a public key of the selected local registration server; and registering the user to the selected local registration server and receiving a partial user-ID file from the selected local registration server.

Downs et al. in analogous art, however, disclose a method wherein

creating a secret/public key pair for a user by using a user digital product license control program installed on a user computer; (Col. 77, lines 24-26)

selecting a particular local digital product registration server from a digital product registration server list; (Col. 77, lines 18-31)

sending the user's public key to the selected local registration server and receiving a public key of the selected local registration server; (Col. 11, lines 66-67; Col. 14, lines 10-13; Col. 32, lines 1-5) and

registering the user to the selected local registration server and receiving a partial user-ID file from the selected local registration server. (Col. 31, Transaction Secure Container Table; End-User(s) ID)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the method disclosed by LeBOURGEOIS and Menezes et al. to include a method further comprising: creating a secret/public key pair for a user by using a user digital product license control program installed on a user computer; selecting a particular local digital product registration server from a digital product registration server list; sending the user's public key to the selected local registration server and receiving a public key of the selected local registration server; and registering the user to the selected local registration server and receiving a partial user-ID file from the selected local registration server. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, Downs et al. (Col. 7, lines 25-28) in order to implement licensing authorization and control so that content is unlocked only by authorized user.

As per claim 11:

LeBOURGEOIS, Menezes et al. and Downs et al. teach all the subject matter as discussed above. In addition, Downs et al. further discloses a method wherein the user digital product license control program attaches the user's secret/public key pair and the public key of the user's digital product registration server to the partial user-ID file that includes user information encrypted by the user's public key and digitally signed by a secret key of the selected local digital product registration server. (Col. 13, lines 42-48; Col. 14, lines 18-27 and lines 54-67; Col. 30, 8-10)

As per claim 13:

LeBOURGEOIS, Menezes et al. and Downs et al. teach all the subject matter as discussed above. In addition, Downs et al. further disclose a method comprising:

downloading public digital products from the Internet by the user; (Col. 84, lines 10-11)

selecting a particular public digital product using the user computer; (Col. 83, lines 34-37)

linking the selected public digital product to a user digital product execution program of the user digital product license control program; (Col. 84, lines 12-14) and

processing the selected public digital product, decrypting said public digital product and reading a product ID from the product registration file by the linked digital product execution program. (Col. 30, lines 23-33; Col. 85, lines 5-60)

As per claim 14:

LeBOURGEOIS, Menezes et al. and Downs et al. teach all the subject matter as discussed above. In addition, Downs et al. further disclose a method comprising:

checking a license file from the selected local registration server to determine whether there is a usage license for the selected public digital product; (Col. 29, lines 54-56)

purchasing a license for the selected public digital product, if there is no license for the selected public digital product and receiving a new license file including the purchased license; (Col. 30, lines 12-23)

changing the selected public digital product into a personal digital product if there is a license; (Col. 30, lines 23-24) and

calling a player to execute the personal digital product. (Col. 91, lines 1-9)

As per claim 17:

LeBOURGEOIS, Menezes et al. and Downs et al. teach all the subject matter as discussed above. In addition, Downs et al. further disclose a method comprising:

transferring the partial user-ID file, the license file and the personal digital product to a specific machine. (Col. 6, lines 47-49; Col. 29, lines 54-56)

As per claim 18:

LeBOURGEOIS, Menezes et al. and Downs et al. teach all the subject matter as discussed above. In addition, Downs et al. further disclose a method further comprising:

storing user information, CPU information and digital product usage license information in a datable of the selected local digital product registration; (Col. 8, lines 13-29; *CPU is interpreted as End-User device; the interpretation is given based on the discussion given on the disclosure*) and

replicating the local digital product registration server database to a central database of the central product registration server. (Col. 8, lines 13-29)

As per claim 19:

LeBOURGEOIS, Menezes et al. and Downs et al. teach all the subject matter as discussed above. In addition, Downs et al. further disclose a method wherein the user-ID file and the license file are updated based on an expiration date or refresh period selected by the user. (Col. 7, lines 25-31)

As per claim 20:

LeBOURGEOIS, Menezes et al. and Downs et al. teach all the subject matter as discussed above. In addition, Downs et al. further disclose a method comprising:

registering CPU associated with the user to the particular local digital product registration server. (Col. 8, lines 13-29)

As per claim 21:

LeBOURGEOIS, Menezes et al. and Downs et al. teach all the subject matter as discussed above. In addition, Downs et al. further disclose wherein in the step of registering the CPU, the user digital product license control program creates a secret/public key pair for the CPU and sends the CPU public key to the particular local digital product registration server which encrypts and digitally signs a license file by using the CPU public key. (Col. 13, lines 42-48; Col. 14, lines 18-27 and lines 54-67; Col. 30, 8-10)

7. Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeBOURGEOIS WIPO Publication WO 98/42098 in view of Menezes et al. publication entitled "Handbook of Applied Cryptography." in view of Downs et al. United States Letter Patent Number 6,574,609 and further in view of England et al. United States Letter Patent Number 6,327,652.

As per claim 12:

LeBOURGEOIS, Menezes et al. and Downs et al. teach all the subject matter as discussed above. Neither of the references explicitly disclose a method further comprising: registering a CPU associated with the user to the selected local digital product registration server; and receiving a license file that includes CPU information

encrypted by the user's public key and digitally signed by the secret key of the selected local digital product registration server.

England et al. in analogous art, however, disclose a method comprising:

registering a CPU associated with the user to the selected local digital product registration server; (Col. 8, lines 4-10) and

receiving a license file that includes CPU information encrypted by the user's public key and digitally signed by the secret key of the selected local digital product registration server. (Col. 9, lines 42-67 and Col. 10, lines 1-3)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the method disclosed by LeBOURGEOIS, Menezes et al. and Downs et al. to include a method further comprising: registering a CPU associated with the user to the selected local digital product registration server; and receiving a license file that includes CPU information encrypted by the user's public key and digitally signed by the secret key of the selected local digital product registration server. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, England et al. (Col. 3, lines 56-58) in order to guarantee that a digital rights management operating system has been properly loaded on a computer. This way, the central digital product registration server verifies the authenticity of the identity of the user player before executing the digital product.

As per claim 16:

LeBOURGEOIS, Menezes et al., Downs et al. and England et al. teach all the subject matter as discussed above. In addition, England et al. further disclose a method wherein the user digital product license control program does not check user information if a "CPU based license" indicator is turned on in the license file. (Col. 9, lines 60-67)

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over LeBOURGEOIS WIPO Publication WO 98/42098 in view Menezes et al. publication entitled "Handbook of Applied Cryptography." in view of Downs et al. United States Letter Patent Number 6,574,609 and further in view of Richardson, III United States Letter Patent Number 5,490,216.

As per claim 15:

LeBOURGEOIS, Menezes et al., Downs et al. teach all the subject matter as discussed above. Neither of the references explicitly disclose a method wherein the user digital product license control program does not check CPU information if a "user based license" indicator is turned on in the license file.

Richardson, III in analogous art, however, disclose a method wherein the user digital product license control program does not check CPU information if a "user based license" indicator is turned on in the license file. (Col. 2, lines 65-67 and Col. 3, lines 1-2)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the method disclosed by LeBOURGEOIS, Menezes et al. and Downs et al. to include a method wherein the user digital product

license control program does not check CPU information if a "user based license" indicator is turned on in the license file. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, Richardson III (Col. 2, lines 53-55) in order to allow digital data or software to run in a use mode on a platform if and only if an appropriate licensing procedure has been followed.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Clark U.S. No. 6,343,280

This reference pertains to a method of protecting software from unlicensed use.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shewaye Gelagay whose telephone number is 571-272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shewaye Gelagay
Examiner
Art Unit 2133

2/04/05

ALBERT DECADY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100